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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,005	05/26/2000	Nir Kossovsky	M-7529-1P US	9931

23639 7590 10/09/2002  
BINGHAM, MCCUTCHEN LLP  
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SAN FRANCISCO, CA 94111-4067

EXAMINER
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BUI, THACH H

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 10/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/580,005

Applicant(s)

KOSSOVSKY ET AL.

Examiner

Thach H Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 12-16, 28-32 and 44-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 17-27, 33-43, 49-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5, 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The preliminary admenment filed November 03, 2000, and April 12, 2001 have been received and entered.

***Information Disclosure Statement***

2. Applicant's prior art citation filed November 2000, February 2001, April 2001 and June 2001 have been received, considered and placed of record.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11, 17-24, 33-40, 49-51, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eder.

As per claim 1, Eder teaches a computer system for providing a valuation of an intellectual property comprising a computer network having at least one server connecting one or more clients, and computer programs (column 8, lines 1-25) (column 17, lines 5-15). Eder also teaches a means for storing information about the intellectual property asset in databases (see Figures 1, 5A-9C), and the information stored in the databases are publicly traded securities according to the technology classification in the databases. In addition, Eder's computer system comprises a means for generating a valuation based on the information about the publicly traded securities stored in the

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database (column 8, line 26-column 12, line 30) (column 21, lines 33-50). Eder does not mention explicitly a means for generating a valuation based on call option pricing theory, but Eder generates a means for valuating an intellectual property based on the information stored in the databases i.e. revenue value, expense value, capital value and etc (column 8, line 26-column 12, line 30). Therefore, it would have been obvious to one having ordinary skill in the art to modify Eder's computer system to perform a valuation based on call option pricing theory.

As per claims 2 and 3, Eder teaches a computer system having multiple databases storing information about the intellectual property asset relating to the estimated time and cost to commercialize a product based on the intellectual property asset, and the information about the intellectual property asset conveying rights (column 8, lines 26-60).

As per claims 4, 20, 36 contain information addressed in claim 1, and therefore, it is being rejected under the same rationale.

As per claims 5, 21, 37, Eder does not mention explicitly the enterprise values are updated periodically bases on the external sources, but Eder teaches a software in the computer system that checks the assets and to determine whether the prices are "current" (column 23, lines 24-44). Therefore, it would have been obvious to one having ordinary skill in the art to recognize that the system, as taught by Eder, is capable to update enterprise values periodically.

As per claims 6, 38, Eder teaches a valuation bases comprising multiple databases storing completed information about the intellectual property asset transactions (column 8, line 26-column 12, line 30) (column 21, lines 33-50).

As per claims 7, 23, 39, Eder does not explicitly mention the Black-Scholes theory. It would have been obvious to one skilled artisan to substitute one application's software for another.

As per claims 8, 24, 40, Eder teaches a software application that evaluates risks of the intellectual property asset. It performs numerous mathematical calculations in evaluating risk i.e. normalized value provided (column 30, lines 45-55) having minimum positive and most negative data value for all elements items, and etc.

As per claims 9, 17, 33, 49-51, and 53, contain features addressed in claim 1, and therefore, it is rejected under the same rationale.

As per claims 10 and 11, Eder does not explicitly mention a computer program having computer instructions in projecting client's yearly income to the seller over the term of the intellectual property asset, based on the suggested selling price, and a balance between immediate and future payments wherein the future payments are modified by a discount rate which depends on a risk valuation of the intellectual property asset. However, Eder teaches a computer system having computer instructions that are capable to display different assets relating to the intellectual property i.e. financial assets, value generating assets, and etc. (see Figures 14, and 15). Therefore, it would have been obvious to one having ordinary skill in the art to modify the computer system, as taught by Eder, to have computer instructions in projecting client's yearly income to

the seller over the term of the intellectual property asset, based on the suggested selling price, and a balance between immediate and future payments wherein the future payments are modified by a discount rate which depends on a risk valuation of the intellectual property asset.

As per claims 18-19, 34-35, contain features addressed in claims 2 and 3, and therefore, are rejected under the same rationale.

4. Claims 25-27, 41-43, 52 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eder in view of the article "Managing The Financial Uncertainties of Technology Transfer" by Nir Kossovsky et al.

As per claims 25-27, 41-43, 52 and 54, they contain features addressed in previous claims. In addition, the claims recite a means for generating a suggested asking price wherein the value of the intellectual property rights is modified according to the licensing conditions. Eder has all the features of the invention (mentioned in the above paragraphs) but does not mention explicitly a means for generating a suggested asking price wherein the value of the intellectual property rights is modified according to the licensing conditions. The article "Managing The Financial Uncertainties of Technology Transfer" teaches licensing conditions that can affect the value of the intellectual property and the risk tolerance of the licensor comparing to the licensee. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the claimed inventions, as taught by both Eder and Nir

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Kossovsky et al. to have a means for generating a suggested asking price wherein the value of the intellectual property rights is modified according to the licensing conditions

***Conclusion***


5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thach H Bui whose telephone number is 703-305-0063. The examiner can normally be reached on Monday-Friday, 7:30-4 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantzy Poinvil can be reached on 703-305-9779. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5711.

T.B.  
September 27, 2002

  
FRANTZY POINVIL  
PRIMARY EXAMINER  
*AA 3628*